

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 3, 4, 8 and 16-18 are pending in the application. Claims 3-4 have been amended in the manner kindly suggested by the Examiner in paragraph 2 of the Office Action. Claim 8 has been amended to better define the claimed invention. New claims 16-18 readable on the elected invention/species have been added to provide Applicants with the scope of protection to which they are believed entitled. The amended/new claims find solid support in the original specification and drawings. No new matter has been introduced through the foregoing amendments.

The indication that the current Office Action is a *final* action found at page 6 appears to be an oversight. Applicants will therefore treat this action as a non-final one as indicated in the Office Action Summary page. However, if it was indeed the Examiner's intention to make the action final, such finality is hereby traversed as being premature, as the amendments presented in the last Amendment have been indicated in the subsequent Advisory Action as raising new issues and, hence, could not have been rejected over the art applied in the previous final Office Action.

The 35 U.S.C. 112, *second paragraph* rejection of claims 3 and 4 is believed overcome in view of the above amendments.

The repeated 35 U.S.C. 103(a) rejection of claims 3, 4, and 8 as being obvious over *Burke* in view of *Harding* and *Hoyle* is traversed for any of the overwhelming reasons presented in numerous Amendments/Responses submitted during prosecution of the instant application. In particular,

Applicants again confirm their consistent position that *Burke* and *Harding* are not properly combinable. All of Applicants' previous arguments traversing the Examiner's improper combination of *Burke* and *Harding* are incorporated by reference herein.

The Examiner's response to Applicants' latest traversing arguments is noted. Applicants respectfully disagree with, at least, the Examiner's rationale and prior art interpretation detailed at paragraph 8 of the current Office Action.

Specifically, Applicants respectfully disagree with the Examiner's characterization of *Burke* as teaching "the desire for ads and menus in the same screen region." *Burke* does not disclose a *single* screen region for displaying ads and menu items. Instead, the reference teaches *multiple* such screen regions. See, for example, column 8 line 29 of *Burke*, i.e., screen areas 540 and 550. The reference does not include an enabling disclosure of ads and menu items being displayed in the same, single screen region. The Examiner's interpretation of the *Burke* reference is therefore inaccurate.

Further, Applicants respectfully disagree with the Examiner's rationale that it would have been obvious to "provide menus that appear when the mouse arrives and ads that appear (menus disappear) when the mouse leaves." It is acknowledged that if *Harding* is properly combinable with *Burke*, menus (such as User Assistance Navigator in Figs. 1-3 of *Harding*) would appear when the mouse arrives and disappear when the mouse leaves. However, the ads would remain visible all the times regardless of the mouse position, because *Harding* does not teach disappearing the ads (or Control, Choice 1, Choice 2 in Figs. 1-3 of *Harding*) when the mouse arrives. Indeed, Control, Choice 1, Choice 2 in Figs. 1-3 of *Harding* do not disappear at all, and remain visible all the times. Thus, in the Examiner's proposed combination of *Burke* and *Harding*

(if proper), when the mouse arrives at the adds (i.e., Control, Choice 1, Choice 2 in Figs. 1-3 of *Harding*), menu items (i.e., User Assistance Navigator in Figs. 1-3 of *Harding*) would appear in addition to the adds as clearly disclosed in Figs. 1-3 of *Harding*. The adds (i.e., Control, Choice 1, Choice 2 in Figs. 1-3 of *Harding*) would remain visible all the times (even when the mouse is in the area) rather than disappearing depending on the mouse position as presently claimed.

Accordingly, Applicants respectfully submit that

1. *Burke* and *Harding* are not combinable for the reasons advanced in the previous Amendments/Responses; and
2. Even if *Burke* and *Harding* could be properly combined in the manner proposed by the Examiner, the references would still fail to teach or disclose all limitations of the claimed invention, i.e., at least the requirement that the advertisement disappears when the cursor is in the area.

The teaching reference of *Hoyle* is not deemed capable of curing the deficiencies of *Burke* and *Harding*. Claims 3, 4, and 8, as well as new claims 16-18 directed to similar features, are therefore clearly patentable over *Burke*, *Harding* and *Hoyle*.

The new 35 U.S.C. 103(a) rejection of claims 3, 4, and 8 as being obvious over *Burke* in view of *Nicholas III* is also traversed for the following reasons.

First, the prior art status of *Nicholas III* has not been confirmed. It is noted that *Nicholas III* can only be applied against the instant application if it is entitled to the earliest effective reference date of its parent, Serial No. 09/314,128.¹ Since the disclosure of Serial No. 09/314,128 is not

¹ MPEP, section 2136.03, IV - Filing Date of U.S. Parent Application Can Only Be Used as the 35 U.S.C. 102(e) Date If it Supports the Claims of the Issued Child

readily available to Applicants, the Examiner is kindly asked to review the disclosure of Serial No. 09/314,128 to determine whether Serial No. 09/314,128 supports the claims of *Nicholas III*. If Serial No. 09/314,128 does not supports the claims of *Nicholas III*, the reference is not prior art and cannot be applied against the instant application.

Second, if *Burke* and *Nicholas III* were properly combinable, which Applicants contend to the contrary, the combined method/system would fail to teach or disclose the claim requirement that the “at least one of a menu bar, tool bar, location bar, and/or browser logo” (hereinafter referred to as “menu items” only for sake of simplicity) disappear when the cursor leaves the area. The Examiner’s proposed combination of *Burke* and *Nicholas III* would disclose, at best, that the advertisement that follows the cursor might be displayed or disappear when the cursor is in the toolbar area, depending on whether such advertisement would disturb the viewer/user or not. However, when the cursor leaves the toolbar area, the *Nicholas III* advertisement that follows the cursor would also leave the toolbar area, and hence the toolbar are would display the regular menu items rather than the advertisement as argued by the Examiner. In other words, the toolbar in *Burke/Nicholas III* would not disappear when the cursor leaves the toolbar area, contrary to the claimed invention.

Claims 3, 4, and 8, as well as new claims 16-18 directed to similar features, are therefore clearly patentable over *Burke* and *Nicholas III*.

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the “>U.S. patent reference<must * have a right of priority to the earlier date under 35 U.S.C. 120 or 365(c) and “>the parent application must< support the invention claimed as required by 35 U.S.C. 112, first paragraph. “For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as ‘secret prior art’” under 35 U.S.C. 102(e). In re Wertheim, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981).

It should be now apparent that the claimed invention is directed to a method or system in which the “menu items” and advertisement are “switched” depending on the cursor position. Thus, one of (1) the “menu items” and (2) the advertisement must disappear when the other is displayed in the area. The Examiner’s proposed combination of *Burke* and *Harding* (and further in view of *Hoyle*) fails to teach or disclose that the advertisement (e.g., Control, Choice 1, Choice 2 in Figs. 1-3 of *Harding*) disappears, whereas his other proposed combination of *Burke* and *Nicholas III* fails to teach or disclose that the menu items (e.g., the toolbar of *Nicholas III*) disappear. Thus, none of the proposed combinations fully teach or disclose the invention as claimed, and therefore the claimed invention is patentable over the applied art of record.

Each of the Examiner’s rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant’s attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,
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